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| 09/771,526 | 01/29/01 | DOBROUNIG | ADI-02UCN |

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EXAMINER

WONG, S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3711

DATE MAILED: 06/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/771,526

Applicant(s)
Dobrounig

Examiner
Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 29, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 24-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/126,876.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification is not seen as setting forth that the outer layer comprises a sheet.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification is not seen as setting forth that the outer skin is formed as a sheet. The applicant cites page 4, lines 15-29 and page 8, line 18 through page 10, line 3 as support for the amendment, however, these lines are not seen as setting forth the outer layer comprising a sheet.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Gentiluomo (4,802,671). Regarding claim 1, Gentiluomo discloses a ball comprising an outer skin (3) including a syntactic material (note column 2, lines 53-58).

Regarding claim 3, Gentiluomo provides a plurality of microspheres dispersed in the foam.

Regarding claims 7 and 9, Gentiluomo provides additional layers (2, 4) adjacent the first layer.

6. Claims 1-4, 6, 7 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Delacoste. Delacoste discloses a ball construction including an outer skin which includes a syntactic material (note column 3, lines 45-62).

Regarding claims 2-4, Delacoste teaches dispersing polymeric hollow microspheres within matrix material.

Regarding claim 6, note column 2, lines 15-18 which teach the use of polyurethanes.

Regarding claim 7, Delacoste teaches an internal layer for the ball.

Regarding claim 28, Delacoste teaches a valve (8) which would inherently define the internal layer as an inflatable bladder core.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 4-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentiluomo (4,802,671) in view of Okumoto et al. (5,516,107). Regarding claims 2 and 11, Okumoto et al. teaches a syntactic foam wherein the microspheres are dispersed in a resin matrix (note column 3, lines 37-48). It would have been obvious to one of ordinary skill in the art to utilize a resin matrix for the syntactic material of Gentiluomo in order to take advantage of that material's well known physical characteristics.

Regarding claims 4 and 5, Okumoto et al. note the use of acrylonitrile copolymer microspheres. It would have been obvious to one of ordinary skill in the art to utilize acrylonitrile copolymer microspheres in the ball construction of Gentiluomo in order to take advantage of that material's well known physical characteristics.

Regarding claim 6, Gentiluomo notes that the foam may be a polyurethane.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentiluomo (4,802,671) in view of Kennedy et al. (5,091,265). Kennedy et al. disclose a ball construction including an outer layer formed from an aliphatic material (note column 4, lines 17-25). It would

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have been obvious to one of ordinary skill in the art to utilize an aliphatic material in the ball composition of Gentiluomo in order to take advantage of that materials' physical characteristics.

10. Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gentiluomo (4,802,671). These claims are seen as product-by-process claims. Therefore, because the final product (as recited in claim 1) is the same as that of Gentiluomo the intermediate steps claimed are seen as being either anticipated or obvious over the reference to Gentiluomo. See MPEP 2113.

11. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentiluomo. It would have been obvious to one of ordinary skill in the art to form the ball of Gentiluomo with the spherical bodies being not more than 20% and not less than 1% by weight of the matrix material as the applicant has not shown the criticality for these particular limitations and it appears that the arrangements of Gentiluomo would accomplish similar purposes.

12. Claims 1-4, 6, 7, 9-12 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik (4,660,831) in view of Delacoste. Regarding claims 1 and 28, Kralik discloses a ball construction including a foam layer (16).

Delacoste teaches a ball construction including a plurality of microspheres. It would have been obvious to one of ordinary skill in the art to include in the foam layer of Kralik a plurality of microspheres as taught by Delacoste in order to reduce ball deformation.

Regarding claims 2-4, 6 and 11, Delacoste teaches dispersing polymeric hollow microspheres within polyurethane material.

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Regarding claims 7, 9 and 10, Kralik provides second and third layers and a layer particularly of woven fabric (24). Note column 3, lines 12-21.

Regarding claim 12, Kralik provides a middle skin (26), a backing layer (20) and an inflatable bladder layer (22).

Regarding claims 24 and 25, Kralik teaches forming the foam material as individual element which are sewn together.

Regarding claims 26 and 27, it would have been obvious to one of ordinary skill in the art to provide the microspheres of Delacoste in the recited amount as the applicant has not shown the criticality for the recited amount and it appears that the amounts taught by Delacoste would accomplish similar purposes.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik (4,660,831) in view of Delacoste and Okumoto et al. Okumoto et al. teach a plurality of acrylonitrile copolymer microspheres within a polyurethane matrix material. It would have been obvious to utilize microspheres formed from acrylonitrile copolymer in order to take advantage of that material's particular physical characteristics.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik (4,660,831) in view of Delacoste and Kennedy et al. (5,091,265). Kennedy et al. disclose a ball construction including an outer layer formed from an aliphatic material (note column 4, lines 17-25). It would have been obvious to one of ordinary skill in the art to utilize an aliphatic material in the ball composition of Kralik in order to take advantage of that materials' physical characteristics

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Conclusion

15. This is a continuation of applicant's earlier Application No. 09/126,876. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

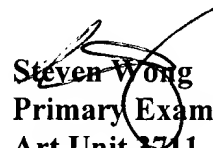
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is (703) 308-3135.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

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Official responses, subject to the provisions of 37 C.F.R. 1.6(d), can be faxed to (703) 305-3579.

Unofficial faxes which are meant for discussion purposes only should be sent to (703) 308-7768. It is strongly suggested that the examiner be contacted directly before sending any unofficial fax.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
May 30, 2001